

Remarks:

Reconsideration of the application is requested.

Claims 1-15 remain in the application.

In the third paragraph on page 3 of the Office action, claims 1-3 and 9-15 have been rejected as being obvious over Tezuka (U.S. Patent No. 3,416,439) in view of Klingel (U.S. Patent No. 4,869,141) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 15 call for, *inter alia*:

a ram head concentrically mounted to the ram and rotatable relative to the frame, the ram head having a centrally disposed bolt.

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Applicants respectfully disagree with the Examiner's comments on page 2 of the Office action, that because the references are from a closely related art, it would have been obvious to one having ordinary skill in the art to replace Tezuka's plural rams with one centrally mounted ram so as to reduce the forces on the frame as taught by Klingel and provide an enhanced structure. Applicants disagree with the Examiner because it cannot be seen why a person of ordinary skill in the art would even consider a combination of Tezuka and Klingel in an obvious manner. Support for applicants position will be provided below.

It is noted that Tezuka discloses a high-pressure press, which is used for compressing scrap metal. Accordingly, the high-pressure press of Tezuka is subjected to extremely high forces and is therefore constructed, with regard to the dimensioning and cooperation of its components, to accommodate high forces. A consequence of such construction is that a plurality of rams (6) are required and are provided next to one another so that the forces that are generated can be suitably distributed among the rams (6). This is contrary to the invention of the instant application, in which one centrally disposed ram is provided. On attempting to modify the device of Tezuka, the person of ordinary skill in the art would take into account, and indeed consider essential, that the modification

necessarily would be suitable for use in high-pressure press applications. Furthermore, any modification would then also have to be able to handle the attendant very considerable forces without limitation. .

This however, does not hold true for the device disclosed in Klingel. This is so because Klingel discloses a punch press, which is provided with a rotatably mounted lower ram portion (34) acting as a punch holder. The lower ram portion (34) is positioned rotatably in order to enable a simple change between different tools or to provide a spatial reorientation of individual tools. It is for this purpose that Klingel is provided with a drive unit, which effects a swiveling of the lower ram portion about its positioning axis in response to predetermined control commands.

Based on the field of use of the Klingel reference it follows that the assembly known from Klingel with all of its components is constructed for use as a punching tool. Klingel is therefore concerned with entirely different structural forces than the high-pressure press according to Tezuka. Therefore, it cannot be seen why a person of ordinary skill in the art would consider a teaching from Klingel to be applicable to the high-pressure press according to Tezuka. Due to the requirements of the construction of the high-

pressure press according to Tezuka, a person of ordinary skill in the art would refrain from using the teaching of Klingel.

Therefore, it is applicants' position that the combination of Tezuka and Klingel is not obvious. Furthermore, applicants point out that the assemblies according to Tezuka and Klingel each have an active adjustment of the orientation of the ram head via an assigned drive. Neither Tezuka nor Klingel teach an embodiment for preventing the introduction of forces which act in a peripheral direction via the ram head into the ram and thus into the frame. [The person of ordinary skill in the art does not obtain any information from either Tezuka or Klingel regarding the criteria of preventing the introduction of forces which act in a peripheral direction as achieved in the present invention, as discussed in the amendment dated February 27, 2003.] Accordingly, a person of skill in the art is not led to address such a concern based on the teaching of Tezuka and/or Klingel. Therefore, there is no reason for a combination of Tezuka and Klingel.

Furthermore, a critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.

Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the

problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Since claim 1 is believed to be allowable, dependent claims 2-14 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 15. Claims 1 and 15 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

It is appreciatively noted from page 3 of the Office action, that claims 4-8 would be allowable if rewritten in independent form to include the limitations of the base claim and any intervening claims. The claims have not been amended in the above-noted manner because they are believed to be allowable in their existing form.

In view of the foregoing, reconsideration and allowance of claims 1-15 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.